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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,443	09/05/2003	Dan Kikinis	P1570D2	1634

24739 7590 07/13/2004

CENTRAL COAST PATENT AGENCY  
PO BOX 187  
AROMAS, CA 95004

EXAMINER

HARRELL, ROBERT B

ART UNIT PAPER NUMBER

2142

DATE MAILED: 07/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/656,443

**Applicant(s)**

KIKINIS, DAN

**Examiner**

Robert B. Harrell

**Art Unit**

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2003.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-10 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 05 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 20030905.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☒ Other: see attached Office Action.

Art Unit: 2142

1. Claims 1-10 are presented for examination.
2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
3. The Cross Reference to Related Documents in the Specification should read as:

--This patent application is a divisional of co-pending application serial number 09/733,777, filed 12/08/2000 titled METHOD AND APPARATUS FOR CONFIGURATION OF AN INTERNET APPLIANCE, now United States Patent US 6,622,169 B2, which is a divisional of co-pending application serial number 09/175,871, filed 10/19/1998 titled METHOD AND APPARATUS FOR CONFIGURATION OF AN INTERNET APPLIANCE, now United States Patent US 6,161,133, each of which are incorporated herein in their entirety by reference.--

4. While examiner considers a "COST" network, as recited in the claims and specification, to be a connection switched telephony (COST) network, such should be mentioned on page 2 (line 12 prior to "COST") of the Specification for application clarity.

5. Other minor errors, that do not rise to the level of indefiniteness, can be found in the claims. For example, "network appliances" of claim 1 (line 6) should be --said network appliances-- for ease of clarity. Also, "the network connection" of claim 1 (lines 6-7) should read as --said connection to said network-- for clarity of reading. Phrases such as "the dial-up server" of claim 3, and "the control routines in the server" plus "the Internet appliance" ("Internet" was struck from claim 1) of claim 4 each lack clear antecedent bases. Even though there are antecedent bases in the Specification upon which the claims are read, not in a void, correct antecedent bases within the claim aid in clarity when defining the invention.

6. Each of the claimed features must be shown in the figures or the features must be cancelled. For example, there is no "control routines", as recited in the claims, in the figures.

7. For the reasons cited above, the Specification and Drawings stand objected. The applicant should use this period for response to thoroughly and very closely proof read and review the whole of the application for correct correlation between reference numerals in the textual portion of the Specification and Drawings along with any minor spelling errors (claim 8 (line 5 "firstb")), general typographical errors, accuracy, and clarity of meaning in the Specification, Drawings, and specifically claims.

8. The non-statutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); In re Van Ornam, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993), In re Berg 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998), 195 F.3d 1322,

Art Unit: 2142

1326, 52 USPQ2d (Fed. Cir. 1999), Eli Lilly CAFC on petition for rehearing En Banc (58 USPQ2d 1869).

9. A timely filed terminal disclaimer in compliance with 37 C.F.R. 1.321 (c) may be used to overcome an actual or provisional rejection based on a non statutory based double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 C.F.R. 3.73(b).

10. Claims 1-10 of this application are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of United States Patent 6,161,133. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons outlined below.

11. Per application claim 1, the patent claims contains every element of this application claim, which removed and then rephrased patent claim limitations, to form a broader application claim in this instant application. As such, the invention defined in this application claim encompasses the invention defined in the patent claim and thus stands obvious over the patent claim. For example, "Internet appliances" has become "network appliances"; however, "network" covers a broader defined invention as such contained all networks including the Internet and others. Also, "The data associated with specific appliances by a telephone number or address used to access the system" and "finding the correct procedure by the association with the telephone number or address used to contact the systems" of the patent claim has been removed and replaced with --including information identifying an account to be used-- which consolidates the so stated patent phrases into a broader definition for the application claim. Thus, in short, the application claim broadens the scope of the patent claim.

12. Application claim 2 recites a "COST" network which is a connection switched telephony (COST) network of the type defined by claim 6 of the patent.

13. Application claim 3 defines an invention that introduces the server as a dial-up type server connected to the Internet which was already covered by patent claim 1. Since application claim 3 is dependent upon application claim 1, application claims 1 and 3 combined defines a broader invention over patent claim 1.

14. Using the corresponding format to map application claims to patent claims using Application Claim Number(s) → Patent Claim Numbers, the remaining application claims also can be seen to encompass the invention defined in the patent claim:

- 4 → 4;
- 5 → 1 or 5 or 8;
- 6 → 6;
- 7 → 7;
- 8 → 1 or 5 or 8;

Art Unit: 2142

9       → 9;  
10       → 3 or 10;

15.     Since the combination and permutations of relationships between application claims and patent claims are numerous to list, examiner need not list all to establish a prima facie case for Obviousness type Double Patenting beyond those already cited above.

16.     Claims 1-10 of this application are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of United States Patent US 6,622,169 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons outlined below.

17.     Per application claim 1, the patent claims contains every element of this application claim, which removed and then rephrased patent claim limitations, to form a broader application claim in this instant application. As such, the invention defined in this application claim encompasses the invention defined in the patent claim and thus stands obvious over the patent claim. For example, "Internet appliances" has become "network appliances"; however, "network" covers a broader defined invention as such contained all networks including the Internet and others. Also, "and specific to different ones of the" and "each of which is pre-programmed with data to dial up and identify itself to the server" of the patent claim has been removed and replaced with the phrase --including information identifying an account to be used-- which consolidates the so stated patent phrases into a broader definition for the application claim. Thus, in short, the application claim broadens the scope of the patent claim.

18.     Using the corresponding format to map application claims to patent claims using Application Claim Number(s) → Patent Claim Numbers, the remaining application claims also can be seen to encompass the invention defined in the patent claim:

2       → 2;  
3       → 3;  
4       → 4;  
5       → 1 or 5 or 8;  
6       → 6;  
7       → 7;  
8       → 1 or 5 or 8;  
9       → 9;  
10       → 10;

19.     Since the combination and permutations of relationships between application claims and patent claims are numerous to list, examiner need not list all to establish a prima facie case for Obviousness type Double Patenting beyond those already cited above.

20.     The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this action:

Art Unit: 2142

A person shall be entitled to a patent unless -

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a); or

21. Claims 1-10 are rejected under 35 U.S.C. 102 (e) as being anticipated by Giordano, III et al. (US 6370141 B1).

22. Prior to addressing the grounds of this rejection, it is noted that each application examined before the Office rise and fall on their own merits. Thus, in light of the above Double Patenting Rejection, the following in no way should be construed as either a direct or indirect challenge as to the validity of any issued Patent. Validity of an issued Patent is a matter of the Court(s). Also, should this application ever be the subject of public review by third parties not so versed with the technology, the following additional indicia in this examiner's Office Action is an aid to refer attention to relevant and helpful elements, figures, and/or text upon which the examiner relies to support his position. Thus, the following citations are neither all-inclusive nor all-exclusive in nature as the whole of the reference is cited and relied upon in this action.

23. Per claim 1, Giordano taught a **system for configuring network appliances** (e.g. see Title), **comprising:**

a) **a server** (e.g., see figure 1 (16) and col. 3 (line 34 "a server 16")) **having a connection to a network** (e.g., see figure 1 (24));

b) **a data repository** (e.g., see figure 2 and col. 3 (lines 41-65)) **accessible by the server** (e.g., col. 3 (lines 35-38)); and

c) **control routines** ("functions" on line 44 of col. 3) **for configuring network appliances via the network connection** (e.g., see col. 3 (lines 42-51));

d) **wherein, upon receiving a request from a network appliance via the network connection, including information identifying an account to be used** ("user name" on line 47 of col. 3), **the control routines consult the database for correct procedure, and interact with the appliance via the network connection to configure the appliance for network access and operation** (e.g., see col. 2 (lines 25-42) and col. 3 (lines 51-65)).

24. Per claims 2 and 3, col. 3 (line 32) stated "dial-up" which was anticipated to be a standard connection switched telephony (COST) network normally used to access an Internet Service Provider's POP (Point Of Presence) to obtain the information from the Internet to use in configuring the appliances.

Art Unit: 2142

25. Per claim 4, col. 2 (lines 6-16) taught of "modifying variables" such as "Internet Service Provider (ISP) telephone numbers" while col. 6 (lines 36-38 and 58-59) taught that the internally "fixed telephone number" (default as shipped to a user) could be changed during the reconfiguration of the appliance. Thus the control routines in the server interacted with compatible control routines pre-programmed in the appliance during configuration and/or reconfiguration. Also note col. 1 (lines 48-59), which alone anticipates "pre-programmed" routines such as programming an Internet Service Provider's access telephone number into the appliance prior to shipping the appliance to an end user.

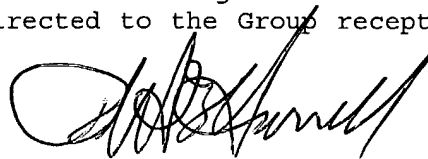
26. Per claims 5-10, these claims do not teach or defined above the correspondingly rejected claims given above, and are thus rejected for the same reasons given above. However, per claim 7, the Web Site hosting the configuration files in Giordano read as being apart of the claimed server cited above which "pushes" appliance dependent (i.e., appropriate) configuration files and/or routines. Per claim 10, security considerations were addressed in col. 4 (lines 11-14) (i.e., but not limited to "Caller ID" of col. 1 (line 56)).

27. A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the data of this letter. Failure to respond within the period for response will cause the application to become abandoned (see MPEP 710.02, 710.02(b)).

28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Harrell whose telephone number is (703) 305-9692. The examiner can normally be reached Monday thru Friday from 5:30 am to 2:00 pm and on weekends from 6:00 am to 12 noon Eastern Standard Time.

29. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack B. Harvey, can be reached on (703) 308-9705. The fax phone numbers for the Group are (703) 746-7238 for After-Final, (703) 746-7239 for Official Papers, and (703) 746-7240 for Non-Official and Draft papers.

30. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.



ROBERT B. HARRELL  
PRIMARY EXAMINER  
GROUP 2142